

REMARKS/ARGUMENTS

Claims 1-20 were pending in this application. No claims have been amended, added, or canceled. Claims 9-12 have been withdrawn. Hence, claims 1-8 and 13-20 are present for examination. Reconsideration of the subject application as amended is respectfully requested.

Claims 1-8 and 13-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the cited portions of U.S. Patent No. 6,801,833 to Pintsov, *et al.* (hereinafter "Pintsov").

Claim Rejections Under 35 U.S.C. § 102(e)

The Applicants respectfully traverse the rejections of all claims since the cited referenced does not teach all the claim limitations, either expressly or inherently as required for a proper rejection under 35 U.S.C. §102(e). Claim 1, for example, recites "wherein the mail items in a tray are addressed to a common recipient." Claims 5, 13, and 18 include a similar element. Pintsov does not teach a plurality of mail items in a tray being addressed to a common recipient. Pintsov teaches processing bulk mail for a common mailer (col. 2:1-7), not a common recipient. The Final Office Action states "Examiner maintains that the common recipient is the post office that receives the items from the mailer." This argument, however, fails to give patentable weight to the claim element. According to the claimed invention, the mail items are *addressed* to a common recipient. Pintsov does not teach that the mail items are all addressed to the post office, as is clearly evident from the mail item depicted in Fig. 1 addressed to "Mr. J HOMEOWNER." Hence, claims 1, 5, 13, and 18 are believed to be allowable, at least for this reason.

Claims 1 and 5 recite "a plurality of mail processing machines that are adapted to process the mail items through any of a plurality of distinct processing paths through the plurality of mail processing machines." Pintsov does not teach mail processing machines. In the response to arguments section, the Final Office Action appears to assume that Pintsov teaches mail processing machines ("These operations require machines..."), even though Pintsov does not teach mail processing machines, much less mail processing machines that are "adapted to process the mail items through any of a plurality of distinct processing paths through the

plurality of mail processing machines." The Final Office Action goes on to misapply the doctrine of inherency to conclude that Pintsov teaches distinct processing paths through the mail processing machines. The Applicants traverse this misapplication of the doctrine of inherency inasmuch as the element is not necessarily present in the reference as required for a proper application of the doctrine. It appears that Pintsov teaches a single processing path, and that processing path is not taught to be through mail processing machines. Hence, claims 1 and 5 are believed to be allowable for this additional reason.

Similarly, claim 13 recites "processing each of the plurality of process segments through different processes." Pintsov does not teach processing through different process segments. Claim 13 is, therefore, believed to be allowable for this additional reason.

Claims 1, 5, 13 and 18 are believed to be allowable for the additional reason that Pintsov does not teach that "each tray tag includes recipient information identifying processing requirements relating to the recipient of the mail items in the tray associated with the tray tag." The Final Office Action failed to address this argument. Moreover, in light of other arguments made by the Final Office Action that the recipient is the post office, each tray tag would be required to include processing requirement for the post office. This is not taught by Pintsov, and claims 1, 5, 13, and 18 are believed to be allowable for this additional reason.

The remaining claims depend from one of these independent claims and are believed to be allowable, at least for the reasons stated above. Claim 15 is believed to be allowable for the additional reasons that Pintsov does not teach that each mail item includes a remittance to the recipient, which, according to the reasons of the final office action would have to be the post office. Claim 16 recites "wherein the mail is processed by a processor for the recipient according to particular processing standards, and wherein the processor receives compensation from the recipient based on the processor's performance with respect to the standard, and wherein the tray tags include information that identifies the processing standards for the recipient relating to the tray." These limitations are not taught by Pintsov. The final office action has not addressed the Applicants' arguments pointing out the shortcomings of the cited reference. Simply saying that "Pintsov does disclose ... a processor receiving

compensation" fails to give patentable weight to the claim elements. Moreover importantly, however, Pintsov does not teach a processor receiving compensation from recipient, which recipient would have to be the post office, according to the arguments presented in the final office action.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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